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09/898,573	07/03/2001	Charles E. Reddick	36968-259627	2886

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EXAMINER

VO, TED T

ART UNIT	PAPER NUMBER
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2191

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/898,573

Applicant(s)

REDDICK ET AL.

Examiner

Ted T. Vo

Art Unit

2191

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed on 01/25/2007.

Claims 36-50 are pending in this application.

Response to Arguments

2. Applicants arguments to the newly added limitations in the claims 36-50 have been considered.

The specification merely mentions that it is providing a computerized guide; thus, with a technician who does not have highly skills can read the instructions in the guide to do the job, such as installing the software. It should be noted that reading a guide in order to do something is only a manual act and it is nature as usual, because it requires a person to do what it is in accordance to the instructions in the guide. For example, every sold item has an included instruction/guide to assist a buyer to assemble or to use the item. Without "human intervention", the instructions cannot produce any result. Furthermore, guidance, including instructions in the guidance, is mere non-functional descriptive materials, what would not be considered as patentable elements. See MPEP 2106:

USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

It should be also noted that in the software development, software application, e.g., software S, is always associated with a version number x. Conventionally named as software S x.

For example, Microsoft has Internet explorer 6 (IE 6), Internet explorer 7 (IE 7), etc.

When a developer upgrades the software S x to a newer version, it promotes the software to newer version A y, where $y > x$, such as IE 6, IE 7. Documentations for installation are also provided;

Art Unit: 2191

otherwise, no one knows how to do. Since the existence of the Internet, Software and its related documents have been available remotely. No one needs to use the post office for a hard package.

Therefore, receiving information, generating emails, and documentation with instructions for a user who reads and follows the guide in the documents to perform a job would be improper to be as patentable features.

It is very common, or by nature, a person A can call person B, who currently has S x, the availability of the version S y. Person B can utilize the Internet to download S y in his computer device; using the guidance to install the software.

With this manually act by its nature as usual, it belongs to public domains.

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)

The current claims appeared to be the same as the above given example, and it appears including manual acts; e.g. using internet emails and requiring a person or a plurality of persons to do every limitations in the claims. Therefore, even acting automatically, In re Venner case, the court rules, replacing a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2191

4. The claims 42, 36-41, and 43-50 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 42, 36-41, and 43-50: A statutory method/process claim requires producing a "useful, concrete and tangible result". State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. In regard to the term "concrete result", the method/process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable.

The claims 42, and the dependent claims, 36-41, and 43-50 are reciting a method that clearly requires human intervention, "a plurality of technicians", "generating an electronic email message", "accessing" (by the technicians - the specification shows email generation, or accessing is performed manually by technicians), etc. Without "technician", the claims cannot constitute a process. Since the acts in the methods such as generating, accessing, are done by the technicians, the claimed method/process cannot be repeatable and the result based on the human performance is unpredictable. With the human intervention in a process, the claims fail to meet the statutory claims; thus the claims are mere abstract idea.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2191

6. Claims 36-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamming et al., "Satchel: Providing Access to Any Document, Any Time, Anywhere", 9-2000. in view of www.Rogers.com, "Portage™ Wireless Connectivity, Quick Start Guide (hereafter: Rogers), 10-2000.

Given the broadest reasonable interpretation of followed claims in light of the specification:

As per claim 42: Lamming's teaching shows it provides software/documents (See p.341-343, start art sec. 6.2) to a plurality of users and mobile workers (See p.332: Fig. 1, and see p.328:sec. 3.2.3, i.e. including 'technicians').

With regard to the preamble: "**A method of providing software and a computerized guide for a plurality of vendors' equipment on a network server for access by a plurality of technicians, the method comprising** (see Fig. 1, and see 341:sec. 6.2.2: e.g. software, and document configuration data are download to a lab-top, and a user uses instructions seen in the lap-top to transfer the software to a telecommunication equipment such as a Nokia 9000).

With regard to the limitation,

"receiving an updated version of a software program on the network server" (Satchel system is within a communication network that allows users/workers to receive information and downloading information; among the information is software and documents, downloaded to the lab-top (see start at p.341:sec. 6.2);

With regard to the limitation,

"generating an electronic email message to a plurality of mobile computers associated with the technicians, wherein the generating is responsive to receiving the update version of the software program"

(It should be noted that, the claimed limitation has entered the public domain: i.e. any computer's user with a standard mail system in his computer can do this. For example, instead of using the telephone to call another person, a user when receives information in an email in his computer device, the user can email to said another person, or anyone he wants. Satchel system also has the email system: see p.348:

Art Unit: 2191

'an email service that allows Satchel users to email any document selectable on the portable device. This provides users with an alternative way of exchanging electronic documents that can extend to non-Satchel users, thus increasing the system's usefulness', any user in this email service would invoke his right to inform anyone using email; including if in the email is discussing new version – Further see p.343: sec. 6.3.2).

and

With regard to the limitation,

"providing the plurality of technicians with access to the updated version of the software and the computerized guide relating to a first vendor's equipment ; and

providing the plurality of technicians with access to second software and a second computerized guide relating to a second vendor's equipment"

(The Satchels' device, such as lab-top or mobile device, has "user interface"; with this interface, anyone using such device can access to the software/documents, locally or remotely. See start at p.341: sec. 6.2);

Lamming's teaching provides a plurality of users/workers user guides for or software installation on mobile equipments such as Nokia 9000s.

However, the teaching is unclear whether guide is online or not. It should be note many computerized guides are implemented in a format using Microsoft Word or PostScript (Lamming, p. 338), and that is clearly presented in the online "Quick Start Guide", where in this Rogers online guide, everyone including a plurality of technicians who are connected into the network like the network shown the teaching of Lamming can be online and downloading into his lab-top and transfer to the Nokia and using the "guide means" for installing the software.

It is obvious to the ordinary in the art at the time of filing, to use the common and available network activities which are discussed in the teaching of Lamming and of Rogers for routing software and a computerized guide from a server data base such as of Roger or of Lamming to every mobile device/equipment, and thus, workers or the technicians do not need to carry the installation manual since the manual is already available online.

As per Claim 40: *"wherein the guide comprises an on-line guide"* As referred to Rogers' Quick Start Guide.

As per Claim 39: Lamming discloses *"The method of claim 42, wherein the guide comprises a printed guide"* Lamming also provides printing facility such that any documents can be printed.

As per Claim 41: Note, the claim requires a reader who reads online, Lamming discloses *"wherein providing the guide further comprises providing an online guide and wherein after followings the instructions in the printed guide the method further comprises following the instruction in the on-line guide only*, because anyone, such as the user reads the user guide or printed in the instructions in the guide.

As per Claim 43: Lamming discloses *"The method of claim 42, wherein loading an updated version of a software program on the network server further comprises loading the updated version of the software program for each of a plurality of equipment in use in a telecommunications system (See Fig. 1).*

As per Claim 45: Lamming discloses, *"wherein the telecommunications equipment comprises a multiplexer"* (See Nokia 9000s, where this device has a multiplexer).

As per Claim 46: Lamming discloses, *"The method of claim 42, wherein the software program comprises a digital loop electronics software program"* (See the example as a software program is updated to the Nokia 9000s)

As per Claim 47: Lamming discloses, *"The method of claim 42, wherein the software program comprise a testing software program"* because the process in the reference is also under testing.

As per claims 36-38, 44, 48-50: The claims recite merely the non-functional descriptive materials that are mere instructions in the guidance, as being unpatentable over Lamming et al., "Satchel: Providing Access to Any Document, Any Time, Anywhere", 9-2000, in view of www.Rogers.com, "Portage™ Wireless Connectivity, Quick Start Guide (hereafter: Rogers), 10-2000.

Claim 36: *"wherein instructions (non-functional descriptive material) for accessing, downloading, and transferring the software program from the network server re.accessible at a plurality of locations at the same time to a plurality of technicians servicing the telecommunications equipment"* – See p.343,

Art Unit: 2191

"user's guide" (for example, a user interface is seen in a mobile device in Fig. 2, p. 333), and further see p. 341, "Installation Software".

Claim 37: *"wherein at least one set of instructions (non-functional descriptive material) further comprises a display of an icon" (similarly to text or labels in a book: non-functional descriptive material)*

Claim 38: *"wherein the icon (non-functional descriptive material, where icon is symbol in the guidance) is associated with the software program and the at least one set of instructions further comprises a description of the software program associated with the icon" (similarly to text or labels in a book: non-functional descriptive material)*

Claim 44: *"comprise instructions (non-functional descriptive material) for accessing software programs for the telecommunications equipment of a plurality of vendors (Note: accessing is an act of the technician upon reading the instructions only. For example, the user guide in the reference is read by its user to install NoKia 9000 software. Note some software also called "Documents" Words document).*

Claim 48: *"The method of claim 42, wherein the instructions (non-functional descriptive material) for accessing a software program on the server further comprise instructions for accessing using software programs for mobile computer tools.*

Claim 49: *The method of claim 42, wherein the instructions (non-functional descriptive material) for accessing a software program on the server further comprise instructions for accessing and using software programs for servicing radio functions on mobile computers.*

Claim 50: *"The method of claim 42, wherein the instructions (non-functional descriptive material) for accessing a software program on the server further comprise instructions for accessing and using software program adapted as job aids for servicing the telecommunications equipment".*

Rogers discloses "instructions" means, where according to the purpose of the job, the instructions guides the users ("a plurality of technician") to follow in do the job, for example, installation software as discussion in Lamming.

However, the above limitations are mere instructions that are in a guidance or a manual; thus are non-functional descriptive material (See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.

Art Unit: 2191

Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) - Descriptive materials will not distinguish the claimed invention from the prior art in terms of patentability).

It would have been obvious to a person of ordinary skill in the art at the time of the filing, to include "instructions" in any means, such instructions are required a person to read and do; such as guiding to install software, to operate an application, or to connect to a network etc; where "instructions" are non-descriptive materials that cannot contribute to patentable factors as in seen *In re Gulack*, and *In re Lowry*.

7. Claims 36-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over manual act

The acts that requires human interaction performs the recitation:

Official notice is taken that, the manual act that is known in the art had performed the steps in the claims:

As per claims 42:

"A method of providing software and a for a plurality of vendors' equipment on a network server for access by a plurality of technicians, the method comprising:

"receiving an updated version of a software program on the network server" (i.e. a mail letter tells a software version; with this recitation, it had been done via hand mails, email notes, or telephone calls)

"generating an electronic email message to a plurality of mobile computers associated with the technicians, wherein the generating is responsive to receiving the update version of the software program" (i.e. a computer user email that had been done before this instant claim, to write any message to a plurality of users who have devices connected in network)

and

"providing the plurality of technicians with access to the updated version of the software and the computerized guide relating to a first vendor's equipment ; and

providing the plurality of technicians with access to second software and a second computerized guide relating to a second vendor's equipment"

(With this claimed recitation, a plurality can receive software by any means, a hand mail package with the software and the computerized installation manual in it. Each of the users who received the package can

Art Unit: 2191

open (i.e. access); or each of the users use the internet for getting software and the online guide. These manual acts had been done before the filing of this application).

It would have been obvious to a person of ordinary skill in the art at the time of filing; any user can act manually using the availability of the communications network. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

As per Claims 39-41, 43, 45-47: The rejections are in the same reason as addressed in the claim 42 above because they are also done manually.

As per Claims 39-41, 43, 45-47: The rejections are in the same reason as addressed in the claim 42 above because they are also done manually.

As per claims 36-38, 44, 48-50: The claims recite merely the non-functional descriptive materials that are mere instructions in the guidance, therefore, it would have been obvious to a person of ordinary skill in the art at the time of filing, to include "instructions" in any means, where non-descriptive materials cannot contribute to patentable factors as in seen *In re Gulack*, and *In re Lowry*.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.


The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may

Art Unit: 2191

be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV
March 30, 2007


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